

REMARKS

This Amendment is responsive to the Office action dated April 27, 2009. By this Amendment, claim 1 has been amended and claims 2-6 remain unchanged.

I. Double Patenting

Claims 1-6 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 7,063,201 (the '201 Patent). The nonstatutory obviousness-type double patenting rejection must be based on a showing that the claims of the '201 Patent either anticipate a claim of the present application or that a claim of the present application would have been obvious in view of one of the '201 Patent claims. MPEP § 804(II)(B)(1). The Applicant respectfully submits that claims 1-6 of the present application are neither anticipated nor obvious in view of the '201 Patent claims.

With respect to anticipation, claim 1 of the present application recites, among other limitations, "wherein the rotation force is conveyed with a predetermined play angle such that the rotation force is not conveyed in a relative rotation direction within the predetermined play angle." Claims 1-20 of the '201 Patent, however, fail to recite a "predetermined play angle." Therefore, a nonstatutory obviousness-type double patenting rejection based on a theory of anticipation is inappropriate.

In establishing a nonstatutory obviousness-type double patenting rejection, the Examiner is required to follow the 35 U.S.C. § 103(a) rejection guidelines based on *Graham v. John Deere Co.*, 383 U.S. 1 (1966). See MPEP § 804(II)(B)(1) (stating that "the analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination"). The MPEP states:

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims – a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent.

The Examiner has not met the burden imposed by the MPEP in making the nonstatutory obviousness-type double patenting rejection. The Examiner's reasoning for the double patenting

rejection consists of one statement: “although the conflicting claims are not identical, they are not patentably distinct from each other because the structure claimed can be interpreted as reading on the current application claims.” Office action, pages 6-7. This reasoning is not sufficient to establish a prima facie case of nonstatutory obviousness-type double patenting.

Furthermore, as discussed above, claims 1-20 of the ‘201 Patent fail to recite a “predetermined play angle.” It would not have been obvious to one of ordinary skill in the art to add a “predetermined play angle” to claims 1-20 of the ‘201 Patent to arrive at the subject matter of claims 1-6 of the present application.

For at least the foregoing reasons, the Applicant respectfully submits that claims 1-6 of the present application are neither anticipated nor obvious in view of the ‘201 Patent claims. Accordingly, reconsideration and withdrawal of the nonstatutory obviousness-type double patenting rejection is respectfully requested.

II. 35 U.S.C. § 102(e) Claim Rejections

Claims 1-6 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,063,201 (the ‘201 Patent). In the Office action, the Examiner stated, “Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP 201.15.” Office action, page 6.

If a reference used by the Examiner in a 35 U.S.C. § 102(e) rejection has an effective date between the present application’s foreign filing date and U.S. filing date, “[t]he applicant in his or her reply may . . . present the foreign papers for the purpose of overcoming the date of the reference.” MPEP § 201.15. “[A]pplicant may be able to overcome the 35 U.S.C. 102(e) rejection by proving he or she is entitled to his or her own 35 U.S.C. 119 priority date which is earlier than the reference’s U.S. filing date.” MPEP § 2136.03. Upon establishing priority, “[t]he foreign application may be considered in the same manner as if it had been filed in this country on the same date that it was filed in the foreign country, and the applicant is ordinarily entitled to any claims based on such foreign application that he or she would be entitled to under our laws and practice.” MPEP § 201.15.

The Applicant has included with this Amendment a certified Japanese to English translation of the priority application JP2004-061933 filed March 5, 2004. The Applicant respectfully submits that the certified translation is sufficient to prove entitlement to the 35 U.S.C. § 119 priority date. Accordingly, the Applicant respectfully requests reconsideration and withdrawal of the outstanding 35 U.S.C. § 102(e) rejection.

III. 35 U.S.C. § 102(b) Claim Rejections

Claims 1-6 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 2002/0130007 (the '007 Publication). Amended claim 1 recites, among other limitations,

a fixing member with teeth, wherein the fixing member is located on an outer circumferential surface of the rotation output member,

a movable lock member with teeth and projecting pins for locking a rotation conveyed from the rotation output member when the movable lock member enters into a pressed state by being pressed toward the fixing member by the rotation output member

. . .

retaining means . . . including guide holes engageable with the projecting pins, wherein the retaining means are operable to retain the position of the movable lock member in the rotation direction when receiving the rotation from the rotation output member.

As shown in Figs. 3 and 7 of the Applicant's specification, for instance, a lock mechanism includes lock gears 35 and a lock ring 33 that each include teeth. The teeth of the lock gears 35 and lock ring 33 can be pressed together to interlock. The interlocking serves to "lock[] the spindle 3 in response to the rotation conveyed from the spindle 3." Specification, paragraph 44.

In contrast, the '007 Publication discloses wedge rollers 24 that wedge against an outer ring to prevent movement of a spindle 28 without the use of teeth. In the '007 Publication, the wedge rollers 24 are configured to roll about their own lengthwise axis as they rotate about the axis of the spindle 28. Col. 9, lines 28-30. "The inclined locking wedge surfaces 37a and 37b

and the inner circumference 39 of the fixing ring 27 cooperate to wedge the wedge rollers 24 in place in a locked position which corresponds to a locked condition of the spindle lock system 10.” Col. 6, lines 32-36. The wedge rollers 24 and the fixing ring 27, however, include no teeth to cause a locked condition. Rather, the wedging of the wedge rollers 24 against the fixing ring 27 creates the locked condition.

Thus, the ‘007 Publication does not teach or suggest “a fixing member with teeth” or “a movable lock member with teeth . . . for locking a rotation conveyed from the rotation output member when the movable lock member enters into a pressed state by being pressed toward the fixing member by the rotation output member.”


Furthermore, claim 1 recites that the movable lock member includes “projecting pins” and that the “retaining means . . . includ[e] guide holes engageable with the projecting pins.” The ‘007 Publication fails to teach or suggest a movable lock member including projecting pins or retaining means with guide holes engageable with the projecting pins. In addition, the wedge rollers 24 of the ‘007 Publication do not have a need for projecting pins that engage with retaining means to perform their function.

For at least the foregoing reasons, the Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claim 1. Claims 2-6, which depend from claim 1, are allowable based upon claim 1 and upon other features and elements recited in claims 2-6 but not discussed herein.

IV. Conclusion

In view of the above, the Applicant respectfully requests entry of this Amendment and allowance of pending claims 1-6. The undersigned is available for telephone consultation at the number below.

Respectfully submitted,

A handwritten signature in cursive script, reading "Carlo M. Cotrone".

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